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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,566	02/25/2002	Edwin C. Slagel	SGP-001-CIP-III	1163

7590 03/21/2003  
Shaw Pittman LLP  
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EXAMINER

MULLIS, JEFFREY C

ART UNIT PAPER NUMBER

1711

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/080,566

Applicant(s)

SLAGEL, EDWIN C.

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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The Table II entries are cut in the left hand column.  
Correction is required.

The term "E-caprolactone" is not art recognized but the only reasonable interpretation of this term appears to be epsilon-caprolactone. Applicant may submit evidence that E-caprolactone is known in the art to mean epsilon caprolactone or should otherwise correct this term or provide a definition which indicates that "E-caprolactone" is actually meant to be epsilon caprolactone.

The second to the last line of claim 1 contains a space between "3," and "5". Correction is required.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Slagel (USP 6,127,505).

Slagel discloses an impact resistant polyurethane composition containing applicant's diamines, isocyanates and hydroxyl containing prepolymers in applicant's proportions (note

patent claim 1) to which may be added triols such as trimethylol propane at a level of 4-8% by weight based on total reactants (note the paragraph bridging columns 5 and 6). Note also that amount of triol is disclosed to be added to result in 1% cross-linking. Note Example V in Table 2 of the patent which contains materials in such an amount that if the 4% level of trimethylol propane were added, a level of somewhat less than 0.5 equivalents based on total equivalents of applicant's materials "i" and "ii" would result, within the metes and bounds of that required by the claims. However there are no such examples of such a material although patentees' specification broadly discloses that polyurethans may be produced using such levels of triols.

It would have been obvious to a practitioner having ordinary skill in the art at the time of the invention to produce polyurethans having applicant's level of triols based on the disclosure of Slagel since Slagel et al. specifically discloses the levels of triols in their polyurethans which broadly embrace applicant's levels and in the expectation of adequate results, absent any showing of surprising or unexpected results.

In a Continuation-in-Part (CIP), a foreign priority more than one year before the CIP becomes a valid reference under 35 U.S.C. § 102(b). Note in this regard In re Ruscetta and Jenny, 118 USPQ 101 (CCPA 1958) and In re Lukach, Olson and Spurlin, 169

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USPQ 795 (CCPA 1971) and In re Hafner, 161 USPQ 783 (CCPA 1969) in this regard.

It is noted that applicant's parent cases to which priority is claimed do not disclose applicant's complete range of equivalents of triol and therefore the parent cases do not support the instant claims in their full breadth. Therefore the effective filing date of the instant case is 2-25-02 and the art relied upon above is prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (703) 308-2820. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for this Group is before final (703) 872-9310 and after final (703) 8729311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

J. Mullis:cdc

March 19, 2003

Jeffrey Mullis  
Primary Examiner  
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